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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/686,563 | 10/11/2000 | Ying-Li Wu | QWEST# 1789 | 5238 |

22193 7590 01/21/2004

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EXAMINER

FERRIS, DERRICK W

ART UNIT PAPER NUMBER

2663

DATE MAILED: 01/21/2004

4

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/686,563

Applicant(s)

WU ET AL.

Examiner

Derrick W. Ferris

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17, 19-26 (renumbered as 1-25) is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 October 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other: _____

DETAILED ACTION

Drawings

1. The drawings are objected to because the reference numbers for the boxes in figure 1 do not have labels. Please provide labels for each box for figure 1. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Objections

2. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 19-26 been renumbered 18-25 (i.e., claim 18 is missing). **Please use the new numbering scheme when replying to the Office action. The current Office action uses the new numbering scheme.**

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. **Claim 25** (original claim 26) is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the

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relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 25 depends on claim 21. Claim 21 recites in step (1) a step of initiating a communication with a terminating connection using an analog modem. Support for claim 25 is found, inter alia, at page 5, lines 11-18. Also see applicant's figure 3, steps 104, 106, and 108. In particular, in a process of classifying a facsimile machine a facsimile machine (and only a facsimile machine) is identified (emphasis page 5, lines 11-12). Thus not supported is the concept of identifying an analog machine while classifying a facsimile machine (i.e., see page 5, lines 2-10). Specifically applicant's specification teaches in initiating a communication with an analog modem (i.e., analog machine) an analog modem is classified (and not a facsimile machine). Thus claim 25 is not possible.

For the purpose of making the rejection, the examiner makes assumption that it would have been obvious to select any protocol in general as taught by *Milbrandt*.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. **Claim 18** (original claim 19) is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 18 depends on claim 18 which did not exist. Examiner assumes applicant means claim 17.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. **Claims 1 and 2** are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,404,400 A to *Hamilton*.

As to **claim 1**, for a modem communicating with a telephonic network 1020 see figure 1 (e.g., block 2040) of *Hamilton*. For a dialog processing device communicating with said telephonic network 1020 see e.g., column 4, lines 1-25. For a controller communicating with said modem and said dialog processing device to identify a terminating connection of said telephone network see controller 2050 in figure 1.

As to **claim 2**, implicitly taught is a telephone number for a terminating connection (e.g., see block 1040 in figure 1).

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. **Claims 1-25 (renumbered)** are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,633,545 B1 to *Milbrandt*.

As to **claim 1**, for a modem communicating with a telephonic network see modems 60 and 42 in figure 1. For a dialog processing device communicating with said telephone network see e.g., system management server 18 and system interface control 68. For a controller communicating with said modem and said dialog processing device

to identify a terminating connection of said telephone network see e.g., COMM server 58 in figure 1 (e.g., see column 6, lines 54-60).

As to **claim 2**, see figure 4, fields 402 and 404.

As to **claim 3**, see figure 1 comm device info 29 with respect to figure 4.

As to **claims 4 and 5**, see figure 4 with respect to column 24, lines 4-53.

As to **claims 6-9**, see e.g., column 24, lines 33-53.

As to **claim 10**, see column 3, lines 66-67.

As to **claim 11**, for a step of initiating communication, see e.g., column 10, lines 36-52. For steps of identifying a communication and classifying a type see e.g., column 24, lines 33-53. For a step of recoding a type, see e.g., column 10, lines 27-35.

As to **claim 12**, see e.g., column 24, lines 33-53.

As to **claim 13**, see e.g., system management server 18 and system interface control 68.

As to **claim 14**, see e.g., column 5, lines 53-67.

As to **claims 15-16**, see column 11, lines 50-61 and column 24, line 65 through column 25, line 67. In particular column 5, lines 52-67 disclose that rate depends on noise and interference where noise and interference are used as a predetermined threshold (e.g., see column 25, lines 5-21). See further column 27, line 7 – column 28, line 16 with respect to figure 8.

As to **claim 17**, see similar rejection to claim 9 (i.e., return filed may be column 408 in figure 4). See also column 6, lines 54-60 with respect to off-hook detection.

As to **claim 18 (original claim 19)**, see figure 8.

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As to **claims 19-20**, see figure 4.

As to **claims 21-22**, in addition to the rejection to claim 11, *Milbrandt* teaches any protocol such as an analog modem and with respect to a dialog processing device see e.g., the further rejection of claim 13.

As to **claim 23**, see similar rejection to claim 14.

As to **claims 24-25**, see similar rejections to claims 15-16.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- US006580788B1 (same possible assignee) discloses gathering statistics for devices in a CLEC and determining, based on the monitoring, whether each device is a modem.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Derrick W. Ferris whose telephone number is (703) 305-4225.


The examiner can normally be reached on M-F 9 A.M. - 4:30 P.M. E.S.T.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chau Nguyen can be reached on (703) 308-5340. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 305-3900.

Derrick W. Ferris
Examiner
Art Unit 2663

DWF 


CHI PHAM
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600 11/15/04